



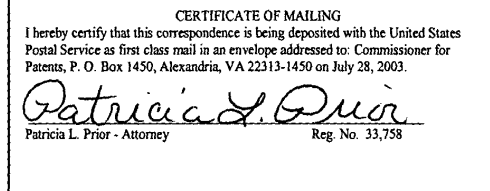
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

RECEIVED
AUG 01 2003
TC 1700

In the Application of

Applicants : Mohsen S. Marzouk and Jeffrey Andrew Reynolds
Serial No. : 09/811,199
Filed : March 16, 2001
Title : PRIMER/PRIMER SURFACER
Docket No. : FIB 0094 PA
Art Unit : 1714
Examiner : Edward J. Cain

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450



Sir:

BRIEF ON APPEAL

This is the Brief on Appeal (in triplicate) in the appeal from the Office Action mailed May 8, 2002, finally rejecting claims 16-25, all of the claims in this application. A Notice of Appeal was timely mailed on June 6, 2003. A check in the amount of \$320.00, which is the indicated fee for a Brief on Appeal under 37 C.F.R. §1.17(c), is enclosed.

Real Party in Interest

The real party in interest is the assignee of this patent application, Illinois Tool Works, Inc., by assignment from the named inventor.

Related Appeals and Interferences

Applicants know of no other appeals or interferences involving related cases which would have any effect or bearing on this appeal.

07/31/2003 HBERHE 00000037 09811199

01 FC:1402

320.00 OP

Serial No. 09/854,017
Docket No. BAT 0028 NA

Status of Claims

Claims 16-25 are present in this application. Claims 16-25 stand rejected. Accordingly, claims 16-25 are before this Board on appeal. A correct copy of the appealed claims appears as an Appendix to this Brief.

Status of Amendments

The claims were not amended after final rejection.

Summary of the Invention

The present invention relates to a primer composition having reduced VOC levels, excellent shelf life and performance characteristics, and to a method of making such a primer composition, as well as to a stabilized methyl ethyl ketone peroxide catalyst used in the primer composition. The primer composition includes an ester; and a stabilized methyl ethyl ketone peroxide catalyst consisting essentially of methyl ethyl ketone peroxide and a sufficient amount of solvent to stabilize the methyl ethyl ketone peroxide, wherein the solvent is selected from ethyl acetate, methyl acetate, t-butyl acetate, or mixtures thereof. The primer composition has a shelf life of over 6 months.

The method of making a stabilized primer composition includes mixing methyl ethyl ketone peroxide with a sufficient amount of solvent to form a stabilized methyl ethyl ketone peroxide catalyst having a shelf life of over 6 months, wherein the solvent is selected from ethyl acetate, methyl acetate, t-butyl acetate, or mixtures thereof; and adding the stabilized methyl ethyl ketone peroxide catalyst to a primer composition to form the stabilized primer composition, wherein the stabilized primer composition has a shelf life of over 6 months.

The stabilized methyl ethyl ketone peroxide catalyst consists essentially of methyl ethyl ketone peroxide, and a sufficient amount of a solvent to stabilize the methyl ethyl ketone peroxide to form the stabilized methyl ethyl ketone peroxide catalyst, the solvent selected from ethyl acetate, methyl acetate, t-butyl acetate, or mixtures thereof. The stabilized methyl ethyl ketone peroxide catalyst has a shelf life of over 6 months.

Serial No. 09/854,017
Docket No. BAT 0028 NA

Issues Presented

The issues presented for review on appeal are:

- 1) whether the examiner erred in rejecting claims 16-25 under 35 U.S.C. §102(b) as being anticipated by Parish; and
- 2) whether the examiner erred in rejecting claims 16-25 under 35 U.S.C. §102(e) as being anticipated by Patel.

Grouping of Claims

The Examiner has rejected claims 16-25 over Parish and over Patel. Claims 16-20 are believed to be patentable for the same reasons. Claims 21-23 are believed to be independently patentable over the art, and claims 24-25 are also believed to be independently patentable over the art. Accordingly, applicant submits that the claims do not stand or fall together. Rather, the patentability of claims 16-20 as one group, claims 21-23 as a second group, and claims 24-25 as a third group will be argued separately below.

The References

Parish, U.S. Patent No. 5,843,221

Parish is directed to a sprayable, high solids, low-volatiles composition for coating a variety of substrates. The sprayable filler composition comprises a first filler/glazing component formed from a mixture of a resin, a filler, a mixture of thixotropic clays, a phosphosilicate, and a first organic solvent. The coating also has a second organic solvent component, as well as a catalyst component.

Patel, U.S. Patent No. 6,051,242

Patel describes a quick drying coating composition useful as a fingernail polish. The composition comprises a base or lacquer component and an optional pigment component. The base component includes film-forming polymers, a monomer compatible with polymers, and a free radical source.

Summary of the Argument

Parish does not anticipate the claimed invention. Parish does not disclose a stabilized methyl ethyl ketone peroxide catalyst, a primer composition containing a stabilized methyl ethyl ketone peroxide catalyst, or a method of making a stabilized primer composition.

Patel does not anticipate the claimed invention because it does not disclose a stabilized methyl ethyl ketone peroxide catalyst, a primer composition containing a stabilized methyl ethyl ketone peroxide catalyst, or a method of making a stabilized primer composition.

Argument

1. Parish Does Not Anticipate Claims 16-25

A. Parish Does Not Anticipate Claims 24-25

Parish teaches a sprayable, high solids, low volatiles filler composition which includes a first filler/glazing component, a catalyst component, and a second organic solvent component. The first filler/glazing component includes ester resin, sprayable filler, thixotropic clays, phosphosilicate, an optional accelerator, and an optional first solvent. See col. 2, line 50 to col. 3, line 10. The optional first solvent is chosen from the group consisting of a highly volatile solvent, such as acetone, a solvent of medium volatility, such as ethyl acetate, and a solvent of low volatility, such as para methyl glycol ether acetate or mixtures thereof. See col. 5, lines 25-33. The optional first solvent is part of the first filler/glazing component. See col. 2, lines 63-65, col. 5, lines 61-63, col. 6, lines 22-23, col. 6, lines 47-48, col. 7, lines 4-5, and claims 1 and 13.

The second organic solvent component is chosen from the group consisting of solvents of low volatility. Such solvents have high molecular weights and high flash points. See col. 5, lines 34-50. As defined by the patent, ethyl acetate is a solvent of medium volatility, not a solvent of low volatility. See col. 5, lines 26-27. In addition, the second organic solvent is added to the filler/glazing component.

The addition of the second organic solvent component to the filler/glazing component results in a coating wherein paint “pop-out” is reduced or eliminated and wherein there is not an undesirable [sic] degree of an “orange-peel” effect. Therefore, the two most unique properties of the coating (its resistance to paint “pop-out” and its ability to provide a surface which, because of it does not exhibit an undesirable degree of an “orange peel”

effect, is immediately suitable for subsequent application of top coats) are the result of *the addition of the second organic solvent component to the filler/glazing component.*

Col. 5, lines 40-50.

The catalyst component, which can be methyl ethyl ketone peroxide, is added to the filler/glazing component *after* the second organic solvent is added.

Still further, the coating includes, as a reduction step *prior to addition of the catalyst component*, a second organic solvent or organic solvent mixture of low volatility.

Col. 6, lines 6-8. See col. 6, lines 30-34, col. 6, lines 54-58, and col. 7, lines 11-15.

The examiner stated that “Applicants’ claims are directed to a composition comprising ester, methylethylketone peroxide, and either ethyl acetate, methyl acetate or butyl acetate and compositions directed to methylethylketone peroxide and solvent.”

However, this statement ignores the language of the claims. Claim 24 recites “a stabilized methyl ethyl ketone peroxide catalyst consisting essentially of: methyl ethyl ketone peroxide; and a sufficient amount of a solvent to stabilize the methyl ethyl ketone peroxide, the solvent selected from ethyl acetate, methyl acetate, t-butyl acetate, or mixtures thereof, wherein the stabilized methyl ethyl ketone peroxide catalyst has a shelf life of over 6 months.”

Parish does not disclose a stabilized methyl ethyl ketone peroxide catalyst, as claimed. Parish does not describe adding a solvent (or anything else) to the methyl ethyl ketone peroxide to stabilize it, or for any other purpose. In Parish, the first solvent is part of the filler/glazing component, and the second organic solvent is added to the filler/glazing component *before* the methyl ethyl ketone peroxide is added. Parish does not stabilize the methyl ethyl ketone peroxide by the addition of a solvent or any other material. Therefore, Parish does not teach the stabilized methyl ethyl ketone peroxide catalyst, as claimed.

According to the examiner, “since the compositions of the reference are chemically equivalent to those of the instant claims, then the stabilizing effect claimed instantly would be inherent to the composition of the reference.” The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP § 2112. The examiner must provide a basis of fact and/or technical

Serial No. 09/854,017
Docket No. BAT 0028 NA

reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. MPEP § 2112.

The examiner has not done so. As discussed above, Parish's composition is not "chemically equivalent" to the claimed stabilized methyl ethyl ketone peroxide catalyst. Parish does not combine methyl ethyl ketone peroxide with anything before it is added to the filler/glazing component. The only solvents used in Parish's composition are either part of the filler/glazing component or are added to it before the methyl ethyl ketone peroxide is added. There is no disclosure in Parish of "a stabilized methyl ethyl ketone peroxide catalyst consisting essentially of: methyl ethyl ketone peroxide; and a sufficient amount of a solvent to stabilize the methyl ethyl ketone peroxide, the solvent selected from ethyl acetate, methyl acetate, t-butyl acetate, or mixtures thereof, wherein the stabilized methyl ethyl ketone peroxide catalyst has a shelf life of over 6 months," as claimed. Because Parish does not disclose the same composition as the claimed stabilized methyl ethyl ketone peroxide catalyst, there is no reasonable basis to believe that the stabilizing effect is inherent in Parish's composition.

Therefore, Parish does not anticipate claims 24-25.

B. Parish Does Not Anticipate Claims 16-20

The examiner's statement that "Applicants' claims are directed to a composition comprising ester, methylethylketone peroxide, and either ethyl acetate, methyl acetate or butyl acetate and compositions directed to methylethylketone peroxide and solvent," also disregards the language of claim 16. Claim 16 recites a "primer composition comprising: an ester; and a stabilized methyl ethyl ketone peroxide catalyst consisting essentially of methyl ethyl ketone peroxide and a sufficient amount of solvent to stabilize the methyl ethyl ketone peroxide, wherein the solvent is selected from ethyl acetate, methyl acetate, t-butyl acetate, or mixtures thereof; wherein the primer composition has a shelf life of over 6 months." As discussed above, Parish does not teach a stabilized methyl ethyl ketone peroxide catalyst, as claimed.

According to the examiner, "Parish requires a composition comprising ester, solvent, and peroxide. Parish specifically recites ethyl acetate solvent and methylethylketone peroxide in the claims. . . . It is inescapable that Parish teaches a composition of ester, ethyl acetate, and

Serial No. 09/854,017
Docket No. BAT 0028 NA

methylethylketone peroxide.” While those materials are present in Parish’s composition, the claimed invention is not anticipated by Parish because applicants’ claimed composition is not a mixture of an ester, solvent, and catalyst. Rather, it is a mixture of ester and a stabilized methyl ethyl ketone peroxide catalyst. Parish’s methyl ethyl ketone peroxide is not stabilized, as discussed above. Accordingly, Parish does not teach the claimed primer composition.

Moreover, Parish does not teach a primer composition with a shelf life of over 6 months, as claimed.

The examiner’s inherency argument is equally inappropriate with regard to claims 16-20. Parish’s composition is not “chemically equivalent” to the claimed primer composition. There is no stabilized methyl ethyl ketone peroxide catalyst, as claimed. Therefore, there is no reasonable basis to believe that the stabilizing effect is inherent in Parish’s composition.

Therefore, claims 16-20 are not anticipated by Parish.

C. Parish Does Not Anticipate Claims 21-23

Parish does not teach the claimed method of making a stabilized primer composition. Claim 21 recites “mixing methyl ethyl ketone peroxide with a sufficient amount of solvent to form a stabilized methyl ethyl ketone peroxide catalyst having a shelf life of over 6 months, wherein the solvent is selected from ethyl acetate, methyl acetate, t-butyl acetate, or mixtures thereof; and adding the stabilized methyl ethyl ketone peroxide catalyst to a primer composition to form the stabilized primer composition, wherein the stabilized primer composition has a shelf life of over 6 months.”

In contrast, Parish does not teach mixing the methyl ethyl ketone peroxide with any material prior to adding it to the filler/glazing component. Parish teaches preparing the filler/glazing component, adding the second organic solvent to the filler/glazing component, and then adding the catalyst component to the filler/glazing component.

The examiner’s inherency argument is inapplicable to the method claims. Parish’s method of making its composition is not the same as the claimed process. Because the processes are different, there is no reasonable basis for asserting that the stabilizing effect is inherent in the product produced by the claimed process.

Thus, Parish does not teach the claimed method of making a stabilized primer composition. Therefore, Parish does not anticipate claims 21-23.

2. Patel Does Not Anticipate Claims 16-25

A. Patel Does Not Anticipate Claims 24-25

Patel teaches quick drying coating compositions for fingernails. The base component includes a primary film-forming polymer, a secondary film-forming polymer, a reactive species compatible with the film-forming polymers, plasticizer, a solvent system, and a free radical source. The coating compositions can include pigment components, if desired.

The primary and secondary film-forming polymers of the base component can be polyesters. See col. 3, line 58 to col. 4, line 55. The solvent systems suitable for use in the base component typically include ethyl acetate with at least one of isobutyl acetate and butyl acetate, although other solvents can be used. See col. 7, lines 26-49. The free radical source can be methyl ethyl ketone peroxides, among other compounds. See col. 6, line 58 to col. 7, line 3.

The examiner's statement that "Applicants' claims are directed to a composition comprising ester, methylethylketone peroxide, and either ethyl acetate, methyl acetate or butyl acetate and compositions directed to methylethylketone peroxide and solvent," ignores the language of claim 24, which requires a stabilized methyl ethyl ketone peroxide catalyst. Patel does not describe a stabilized methyl ethyl ketone peroxide catalyst. Patel states that the free radical source can be added to the base component as a separate component or in combination with one or more of the other components, e.g., in combination with a film-forming polymer. See col. 7, lines 18-21. The examples show the incorporation of the free radical source in polyethyl methacrylate polymer, one of the film-forming polymers. See Examples 1-4, col. 11, lines 3-23. There is no reason for Patel to combine the free radical source with the solvent. And certainly, there is no description in Patel of adding solvent to the methyl ethyl ketone peroxide to stabilize it. Rather, Patel suggests to one skilled in the art adding the free-radical source to the film-forming polymers and monomer in order "to cause the base composition to dry in ambient atmosphere in less than about 70 seconds." (See col. 6, lines 58-61). That accomplished because "[t]he free radical source facilitates reaction of the monomer component --- with the film-

Serial No. 09/854,017
Docket No. BAT 0028 NA

forming polymers in the base composition, once the composition is applied as a thin film coating to a substrate such as a nail.” (See col. 7, lines 9-17). Thus, Patel does not teach a stabilized methyl ethyl ketone peroxide catalyst, as claimed.

The inherency argument is inapplicable to claims 24-25. As discussed above, Patel’s composition is not “chemically equivalent” to the claimed stabilized methyl ethyl ketone peroxide catalyst. Patel does not teach adding a solvent to the free radical source. Therefore, there is no reasonable basis to assert that the stabilizing effect is inherent in Patel’s composition.

Patel does not teach the claimed stabilized methyl ethyl ketone peroxide catalyst. Therefore, Patel does not anticipate claims 24-25.

B. Patel Does Not Anticipate Claims 16-20

The examiner’s statement that “Applicants’ claims are directed to a composition comprising ester, methylethylketone peroxide, and either ethyl acetate, methyl acetate or butyl acetate and compositions directed to methylethylketone peroxide and solvent,” disregards the language of claim 16. Claim 16 recites a “primer composition comprising: an ester; and a stabilized methyl ethyl ketone peroxide catalyst consisting essentially of methyl ethyl ketone peroxide and a sufficient amount of solvent to stabilize the methyl ethyl ketone peroxide, wherein the solvent is selected from ethyl acetate, methyl acetate, t-butyl acetate, or mixtures thereof; wherein the primer composition has a shelf life of over 6 months.” As discussed above, Patel does not teach a stabilized methyl ethyl ketone peroxide catalyst, as claimed.

The examiner’s inherency argument is inapplicable to claims 16-20 because Patel’s composition is not “chemically equivalent” to the claimed primer composition. There is no stabilized methyl ethyl ketone peroxide catalyst, as claimed. Therefore, there is no reasonable basis to believe that the stabilizing effect is inherent in Patel’s composition.

Therefore, claims 16-20 are not anticipated by Patel.

C. Patel Does Not Anticipate Claims 21-23

Patel does not teach the claimed method of making a stabilized primer composition. In Patel, the base component is formed by mixing the solvents to produce a low boiling point

Serial No. 09/854,017
Docket No. BAT 0028 NA

solvent system. The monomer component is then added to the solvent system. Then, a primary film-forming polymer, a secondary film-forming polymer, and at least one plasticizer are added stepwise in any order in conjunction with vigorous mixing until a viscous solution is produced. After the viscous solution is produced, an optional thixotropic agent may be added, if desired, to the solution in conjunction with vigorous stirring for a period sufficient to produce the base component. No mention is made in the examples of the addition of the free radical source, apparently because it is incorporated in the film-forming polymers. See col. 9, lines 40-50 and Examples 1-4, col. 11, lines 3-23. Thus, it is stated at col. 7, lines 18-21, "The free-radical source may be added to the base composition as a separate component or may be added in combination with one or more of the other components, e.g., in combination with a film-forming polymer."

Claim 21 recites "mixing methyl ethyl ketone peroxide with a sufficient amount of solvent to form a stabilized methyl ethyl ketone peroxide catalyst having a shelf life of over 6 months, wherein the solvent is selected from ethyl acetate, methyl acetate, t-butyl acetate, or mixtures thereof; and adding the stabilized methyl ethyl ketone peroxide catalyst to a primer composition to form the stabilized primer composition, wherein the stabilized primer composition has a shelf life of over 6 months." Patel does not teach mixing the free radical source with a solvent prior to adding it to the base component composition, nor does it teach adding the free radical source to the solvent system first. Moreover, Patel does not teach a stabilized methyl ethyl ketone peroxide catalyst with a shelf life of over 6 months.

The examiner's inherency argument is inapplicable to the method claims. Patel's method of making its composition is not the same as the claimed process. Because the processes are different, there is no reasonable basis for asserting that the stabilizing effect is inherent in the product produced by the claimed process.

Thus, Patel does not teach the claimed method of making a stabilized primer composition. Therefore, Patel does not anticipate claims 21-23.

Serial No. 09/854,017
Docket No. BAT 0028 NA

Conclusion

For all of the above reasons, applicants submit that 16-25 are not anticipated by Parish or Patel. Applicants respectfully request that this Board reverse the rejection of the Examiner.

Respectfully submitted,
KILLWORTH, GOTTMAN, HAGAN
& SCHAEFF, L.L.P.

By Patricia L. Prior
Patricia L. Prior
Registration No. 33,758

One Dayton Centre
One South Main Street, Suite 500
Dayton, Ohio 45402-2023
Telephone: (937) 223-2050
Facsimile: (937) 223-0724
PLP/amm
Encl.

APPENDIX

16. A primer composition comprising:
an ester; and
a stabilized methyl ethyl ketone peroxide catalyst consisting essentially of methyl ethyl ketone peroxide and a sufficient amount of solvent to stabilize the methyl ethyl ketone peroxide, wherein the solvent is selected from ethyl acetate, methyl acetate, t-butyl acetate, or mixtures thereof;
wherein the primer composition has a shelf life of over 6 months.
17. The primer composition of claim 16 wherein the ester is selected from polyester, vinyl ester, vinyl polyester, or mixtures thereof.
18. The primer composition of claim 16 wherein the amount of the ester is between 20% and 40% by weight.
19. The primer composition of claim 16 wherein the amount of methyl ethyl ketone peroxide is between 1% and 5% by weight.
20. The primer composition of claim 16 wherein the amount of methyl ethyl ketone peroxide is between 5% and 20% by weight.
21. A method of making a stabilized primer composition comprising:
mixing methyl ethyl ketone peroxide with a sufficient amount of solvent to form a stabilized methyl ethyl ketone peroxide catalyst having a shelf life of over 6 months, wherein the solvent is selected from ethyl acetate, methyl acetate, t-butyl acetate, or mixtures thereof; and
adding the stabilized methyl ethyl ketone peroxide catalyst to a primer composition to form the stabilized primer composition, wherein the stabilized primer composition has a shelf life of over 6 months.

Serial No. 09/854,017
Docket No. BAT 0028 NA

22. The method of claim 21 wherein the amount of methyl ethyl ketone peroxide is between 1% and 5% by weight.
23. The method of claim 21 wherein the amount of methyl ethyl ketone peroxide is between 5% and 20% by weight.
24. A stabilized methyl ethyl ketone peroxide catalyst consisting essentially of:
methyl ethyl ketone peroxide; and
a sufficient amount of a solvent to stabilize the methyl ethyl ketone peroxide to form the stabilized methyl ethyl ketone peroxide catalyst, the solvent selected from ethyl acetate, methyl acetate, t-butyl acetate, or mixtures thereof, wherein the stabilized methyl ethyl ketone peroxide catalyst has a shelf life of over 6 months.
25. The stabilized methyl ethyl ketone peroxide catalyst of claim 24 wherein the amount of methyl ethyl ketone peroxide is between 1% and 5% by weight.